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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,342	03/29/2000	Hironori Morito		6601

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EXAMINER

LEE, TOMMY D

ART UNIT PAPER NUMBER

2624

DATE MAILED: 05/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/537,342

Applicant(s)

MORITO ET AL.

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on amendment filed March 3, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. This Office action is responsive to applicant's RESPONSE TO OFFICE ACTION, filed March 3, 2004. Claims 1-26 are pending.

***Allowable Subject Matter***

2. The indicated allowability of claims 10, 18 and 26 is withdrawn in view of the newly discovered reference(s) to Flannery (U.S. Patent 6,594,405). Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,103,490 (McMillin) in view of U.S. Patent 6,594,405 (Flannery).

Regarding claims 1-9, McMillin teaches a data converting apparatus comprising: a data converting part converting a set of input data into a set of image data that can be processed by an image forming apparatus forming an image on a medium in accordance with the set of image data (column 5, lines 24-41; column 6, lines 25-37); and a superimposing part superimposing at least two sets of image data converted from at least two different sets of input data to generate a single set of superimposed image data, wherein the image forming apparatus forms an image on the medium based on the single set of superimposed image data (column 6, lines 38-56). The data converting apparatus further comprises a data sending part sending the single set of superimposed

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image data to the image forming apparatus (column 6, lines 57-67); a form storing part selectively storing the set of image data converted from the set of input data as a predetermined form that is superimposed, wherein the form storing part comprises a registration part registering the set of image data as a predetermined form that is superimposed (column 5, lines 24-30); a form selecting part selecting one of at least one predetermined form stored by the form storing part (column 7, lines 18-21); a form changing part changing the predetermined form stored by the form storing part, and a store control part selectively storing the predetermined form changed by the form changing part, wherein the form changing part changes layout information of the predetermined form on the medium, which information the form storing part stores by associating with the predetermined form (column 10, lines 3-42); and a previewing part previewing the single set of superimposed image data generated by the superimposing part (column 6, lines 63-68).

The superimposing part disclosed in McMillin does not superimpose the two different sets of input data *in accordance with limitation information showing a limitation of use of at least one set of image data*, as now recited in claim 1, or *storing the limitation information by associating with the predetermined form*, as now recited in claim 3. Flannery, previously cited but not used in any prior rejection of claims, discloses a method and apparatus for combining foreground and background information on a preprinted form (read Abstract), wherein limitation information is used and stored in association with a predetermined form (parameters limiting paper size, number of pages in a form, may be stored for later retrieval (column 4, lines 20-28)). By

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providing such information, a user can provide a composite image in a suitable manner in accordance with specific requirements regarding a size or number of pages, and thus it would have been obvious for one of ordinary skill in the art to provide a means or step of providing and storing limitation information, such as disclosed by Flannery, in the apparatus disclosed by McMillin.

Claim 10 combines the limitations of above-rejected claims 1 and 3, and is thus similarly rejected.

Claims 11-18 are method claims corresponding to above-rejected apparatus claims 1-10, respectively. The steps corresponding to the limitations recited in the apparatus claims are disclosed in the combined teaching of McMillin and Flannery, as set forth above.

Claims 19-26 recite the steps of above-rejected method claims 11-17, respectively, as a program recorded on a computer-readable medium. Storage of a program for performing image processing step in general, while not taught by McMillin, is well known in the art, and it would have been obvious for one of ordinary skill in the art to provide a program for performing the steps taught by McMillin so that such steps may be performed by a computer, without requiring specific image processing hardware for performing each of the steps.

### ***Conclusion***

5. In view of new grounds for rejection not necessitated by amendment, this Office action is non-final.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
May 14, 2004